

REMARKS

Favorable reconsideration of the present application is requested. Claims 27-28 have been canceled without prejudice. Claims 29 and 30 have been added. Claims 1-26 and 29-30 are pending.

The Examiner has withdrawn newly added claims 27 and 28 as being directed to an invention that is independent or distinct from the invention claimed in claims 1-26. Applicant acknowledges the withdrawal of these claims, and has canceled the claims without prejudice or disclaimer.

ALLOWABLE SUBJECT MATTER AND NEW CLAIMS 29 AND 30

As previously noted, the Examiner has not set forth any prior art rejection of independent claim 26. Accordingly, Applicant assumes that this claim would be allowable if the rejection of this claim under 35 U.S.C. § 101 is overcome.

Further, by way of this response Applicant has added claims 29 and 30, which recite features similar to some of the features set forth in claim 26. These claims are believed to be allowable over the art of record.

REJECTION UNDER 35 U.S.C. §101

Claims 1-26 stand rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. Applicant traverses this rejection as follows.

In rejecting claims 1-26, at pages 2-3 the Office Action states:

[...] the claimed invention is rejected due to the fact that it is (1) not tied to another statutory class (such as a particular apparatus), nor does it (2) transform underlying subject matter to a different state or thing.

The claims must to provide a tangible result, and there must be a practical application, by either

1) transforming (physical thing) or

2) by having the FINAL RESULT (not the steps) achieve or produce

a useful (specific, substantial, AND credible),
concrete (substantially repeatable/non-unpredictable), AND
tangible (real world/non-abstract) result.

A claim that is so broad that it reads on both statutory and non-statutory subject matter, must be amended. A claim that recites a computer that solely calculates a mathematical formula is not statutory [...]

The body of claims needs to be tied to a statutory class and produce a concrete, useful and tangible result. For example, how is providing output information, observable and useful in the real world? [...]

Based on [the guidance provided by *In re Bilski*], examiner finds that the claims "initiating an activity" does not specify any particular type or nature of activity, nor does it specify what the activity represents – and is therefore a meaningless limit on a claim to an algorithm because every algorithm inherently initiates some form of an "activity" – and this can further be characterized as insignificant extra-solution activity. *In re Bilski*, 88 USPQ2d 1397-1398 quoting *Grams* and *Flook*."

As the Examiner is apparently aware, *In re Bilski*, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008) addresses the test for patent-eligible processes within the meaning of 35 U.S.C. § 101. In doing so, *Bilski* overruled the useful, concrete and tangible result test set forth in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998), in favor of the machine-or-transformation test set forth by the Supreme Court in *Diamond v.*

Diehr, 450 U.S. 175 (1981). *Bilski* at 1393, 1395.¹ Therefore, the useful, concrete and tangible test is no longer an applicable test for patent eligible subject matter.

Specifically, according to *Bilski* a claimed *process* is patent-eligible under 35 U.S.C. § 101 if:

- (1) it is tied to a particular machine or apparatus, or
- (2) it transforms a particular article into a different state or thing. *Bilski* at 1391.

With respect to method claim 10, Applicant has amended this claim taking into account the Examiner's rejection. As amended, claim 10 is tied to a particular machine or apparatus, namely "a clinical workflow management system in the hospital or hospital department." Indeed, the "clinical workflow management system in the hospital or hospital department" imposes meaningful limits on the scope of the claim by tying the claim to a medical workflow management system in a hospital or hospital department. Moreover, the "clinical workflow management system in the hospital or hospital department" is clearly not insignificant.

With respect to claim 1, it is important to note that the *Bilski* test is for determining whether a *process* is statutory under 35 U.S.C. § 101. *See, e.g.,*

¹ ("...we also conclude that the "useful, concrete and tangible result" inquiry is inadequate and reaffirm that the machine-or-transformation test outlined by the Supreme Court is the proper test to apply...As a result, those portions of our opinions in *State Street* and *AT&T* relying solely on a "useful, concrete and tangible result" analysis should no longer be relied on.").

Bilski at 1387.² But, claim 1 is not directed to a process. Claim 1 is directed to a "workflow management *system*," including "a first *apparatus*," "a second *apparatus*," and "means for *evaluating*." Therefore, Applicant respectfully submits that application of the *Bilski* test to claim 1 is improper. The application of the *Bilski* test to claims 24 and 26 is also improper for similar reasons.

Claims 1, 24, and 26 fall into the enumerated "machine" category of 35 U.S.C. § 101, and therefore, are patent eligible under this statute.

For at least the foregoing reasons, withdrawal of the current rejection under 35 U.S.C. § 101 is requested.

PRIOR ART REJECTION

Rejection under 35 U.S.C. §103

The Examiner rejects claims 1-25 under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,029,144 ("Barrett") in view of U.S. Patent Application Publication No. 2002/0138301 ("Karras"). This rejection is respectfully traversed.

Claim 1 requires "a second apparatus adapted to control activity stages according to said fuzzy process definitions in said clinical workflow for the purpose of processing the process definitions." This feature is not disclosed or

² ("We affirm the decision of the Board because we conclude that Applicants' claims are not directed to patent-eligible subject matter, and in doing so, we clarify the standards applicable in determining whether a claimed method constitutes a statutory "process" under Section 101.").

fairly suggested by Barrett and/or Karras, taken singly or in combination.

Therefore, the resultant combination (assuming *arguendo* such a combination could be made, which Applicant does not admit) fails to render claim 1 obvious.

In the Amendment filed September 26, 2008 (the contents of which is incorporated herein by reference), Applicant argued that the auditor system 256 of Barrett does not "control activity stages according to said fuzzy process definitions in said clinical workflow for the purpose of processing the process definitions" as required by claim 1, and therefore, is not the second apparatus of claim 1.

In response to Applicant's arguments, the Office Action states, at page 7:

...based on the applicant not teaching what the "control" is based on the Examiner asserts that the "control" can be based on input instructions from a human operator and performed by the auditor system as taught by Barrett...

Applicant continues to disagree. Again, according to claim 1, the second apparatus controls activity stages "according to said fuzzy process definitions in said clinical workflow for the purpose of processing the process definitions." Thus, in claim 1 the activity stages are controlled "according to said fuzzy process definitions," rather than by human operator input. A more detailed discussion regarding the differences between Barrett and claim is provided below.

As noted above, the Office Action alleges that the "second apparatus" of claim 1 reads on the auditor system 256 of Barrett. Office Action at 7. Applicant disagrees.

Barrett discloses a system for testing selected expense entries in an audit queue for compliance with established policies and rules before reimbursement payment is made. When an expense entry fails a rule, the entry is flagged and sent to the auditor system (256 in FIG. 2) for manual audit and verification.

Auditor system 256 works with the policy checker 208 to verify significant changes to expense entries that result from the policy checking. But, the auditor system 256 receives only expense entries that have failed rules and changes in the expense entries as recommended by policy checker 208 from audit output 404.

The auditor system 256 of Barrett routes this information to human auditors who accept, reject or modify the changes suggested by policy checker 208. The auditor system 256 does not "control activity stages according to said fuzzy process definitions in said clinical workflow for the purpose of processing the process definitions" as required by claim 1. Control of the auditor system 256 rests *solely with the human auditor* and is not performed *according to fuzzy process definitions*. Indeed, the auditor system 256 does not perform any action without instruction from the human auditor. Thus, the auditor system 256 is not the "second apparatus," of claim 1 because the auditor system 256 does not "control activity stages according to said fuzzy process definitions in said clinical workflow for the purpose of processing the process definitions" as required by claim 1.

Moving forward, Karras discloses the use of medical data in a workflow management system. But, by even cursory review one can appreciate that Karras suffers from at least the same deficiencies as Barrett with respect to claim 1. Namely, Karras fails to disclose or fairly suggest at least "a second apparatus adapted to control activity stages according to said fuzzy process definitions in said clinical workflow for the purpose of processing the process definitions" as required by claim 1. Therefore, even in combination (assuming *arguendo* such a combination could be made, which Applicant does not admit), Barrett and Karras fail to render claim 1 obvious.

For at least the foregoing reasons claim 1 is patentable over Barrett in view of Karras. Claims 10 and 24 are patentable over Barrett in view of Karras for at least reasons somewhat similar to those set forth above. Claims 2-9, 11-23 and 25 are patentable over Barrett in view of Karras at least by virtue of their dependency.

NEW CLAIMS

Applicant has added new claims 29 and 30, which are also believed to be patentable over the cited art. Allowance of new claims 29 and 30 is requested.

CONCLUSION


In view of the foregoing remarks, favorable reconsideration and allowance of the pending claims is requested.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Andrew M. Waxman, Reg. No. 56,007, at the number of the undersigned listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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